



**UNITED STATES DEPARTMENT OF COMMERCE
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TS

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/777,336	12/27/96	HOLMES	D 7-2

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EXAMINER

GELIN, J

ART UNIT

PAPER NUMBER

2744

20

DATE MAILED: 05/30/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
08/777,336

Applicant(s)

David W.J. Holmes

Examiner

Jean A. Gelin

Group Art Unit

2744



☒ Responsive to communication(s) filed on May 18, 2000

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

☒ Claim(s) 1-16 and 21 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-16 and 21 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 18

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

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DETAILED ACTION

1. This is in response to the applicant's continued prosecution application received on May 05, 2000 in which claims 1-16 and 21 are currently pending.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding to claims 12 and 13, the phrase "capable of" renders the scope of the claim vague and indefinite.

It has been held that the recitation that an element is "capable of" performing a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense.

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Claim Rejections - 35 U.S.C. § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-16, and 21 are rejected under 35 U.S.C. 102(b) as being anticipated by Hays et al. (Hays).

Regarding to claim 1, Hays teaches in a communication system (fig. 1) comprising a first over the air network (cellular station 18) and a second over the air network (paging transmitter 30) wherein a mobile station (mobile unit 30) is capable of being coupled to either one of the first and second networks, a method for notifying the mobile station of a communication on one of the first and second a networks to which the station is not presently coupled (i.e., alerting message to mobile, see abstr.), the method comprising the steps of: storing an address and a registration identifier for the mobile station camped on one of said first and second over the air networks (page 9, lines 3-9); receiving a communication request from that one of said first and second over the air networks to which the mobile station is not presently coupled (page 9, lines 10-13); using the stored address of the mobile station camped on one of said first and second over the air networks to send an alert that said communication request has been received (page 9, lines 34-37); wherein said alert informs the mobile station that said communication request is available on

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said one of said first and second over the air networks to which the mobile station is not presently coupled (page 9, lines 3-36); wherein said registration identifier indicates which of said over the air networks said mobile station presently camped on (page 8, line 9 to page 9, line 9); Hays further teaches a paging channel to transmit paging signal, i.e., data, and cellular channel to communicate, i.e., voice (see abstr.)

“With respect to claims 12-13, they have limitations similar to those discussed above, and hence are rejected as being anticipated by Hays et al. for the same reason given above.”

Regarding to claim 2, Hays teaches the steps of: detecting when the mobile station changes it a camp-on status between the first and second over the air networks (i.e., the MTSSO determines or detects when the mobile has switch, page 9, lines 3-13); and updating a memory with an address of the mobile station in the network on which it is camped (i.e., inherently present in page 5, line 26 to page 6, line 25 to locate the mobile unit).

Regarding to claims 3, 4, 8, 9, Hays teaches said first network is a voice network (cellular station 18) and said second network is a paging network (paging transmitter 30), and said first network is a voice network and said second network is a data network (page 7, lines 6-35).

Regarding to claims 5, 7, Hays teaches the mobile station is initially camped on to said first network, said step of storing occurs after the mobile station camps on to the second network (page 9, lines 3-9), and said step of receiving receives a communication request from said first network (page 9, lines 3-31).

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Regarding to claim 6, Hays teaches the step of receiving receives a communication request from said second network (i.e., alerting the subscriber, page 9, lines 10-13).

Regarding to claims 10, 11, Hays further teaches said alert includes information regarding said received communication request, and said information includes how the mobile station should connect to the communication (page 7, lines 2-3, page 9, lines 6-13).

Regarding to claim 14, Hays teaches a communication system for permitting communication requests to follow a mobile station after it changes networks (fig. 1), the system comprising: memory storing an address and a registration identifier of a mobile station on a network to which it is coupled (page 6, lines 1-34); a communication receiver that receives a communications request on a network to which the mobile station is not coupled (i.e., pager receives message for mobile telephone while it is off, page 9, lines 10-15); and a processor, coupled to said memory and said communication receiver and using said address and said registration identifier of the mobile station to alert the mobile station that said communication request was received (i.e., inherent in page 11, line 3 to page 12, line 7); and receiving an indication that said mobile station has changed network status to camp on to the network associated with the communication request (i.e., the pager alerts the subscriber of a message, then the subscriber turns the mobile telephone for communication, page 9, lines 3-34); wherein said registration identifier indicates which of said over the air networks said mobile station presently camped on (page 8, line 9 to page 9, line 9).

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“With respect to claim 21, it has limitations similar to those discussed above, and hence are rejected as being anticipated by Hays et al. for the same reason given above.”

Regarding to claims 15, 16, Hays teaches the mobile station coupled to a wireless voice network and then changes to a data wireless network, said communication request being received by said voice network, and the mobile station is coupled to a data network and then changes to a voice network, said communication request being received by said data network (page 8, line 7 to page 9, line 31).

Conclusion

6. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or faxed to:

(703) 308-6306, (for formal communications intended for entry)

Or:

(703) 308-6296 (for informal or draft communications, please label

"PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive,
Arlington, VA., Sixth Floor (Receptionist).

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7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jean A. Gelin whose telephone number is (703) 305-4847.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.

J. Gelin
May 19, 2000

J.G


TRACY M. LEGREE
PATENT EXAMINER